

**Remarks:**

Claims 1-7 are pending in the application and have been examined. Previous rejections over prior art references Durrwachter and Takahashi, as well as a double patenting rejection over serial no. 10/534,888 have been withdrawn, however the rejections discussed below remain.

Claim 1 is rejected as anticipated by Shibata (U.S. Patent No. 4,636,270; hereinafter "Shibata I"). This reference is cited as disclosing electrical contacts out of an alloy of "Ag-Sn 8%-In 4%." Applicant has amended the claims herein to incorporate the feature of claim 4, which is not rejected as anticipated by Shibata. New claim 8 is added. An additional amendment is made to move the phrase "as additive elements" for the sake of readability. Applicants submit that the amended claims refer to an alloy containing the additive elements, In and Sn, up to 0.5 wt%. The cited Shibata I silver alloy contains 8% Sn and 4% In and contains additive elements at a total of 12%. Thus, this Shibata I alloy contains more than twice the amount of additive elements other than silver as contained in the present invention. The cited Shibata I alloy therefore is completely different from what is claimed here and cannot anticipate the present invention. Applicant therefore requests withdrawal of this rejection.

Claims 2-3 and 5 are rejected as obvious over Shibata I discussed above. In Shibata I, two separate alloys are discussed, i.e., a Ag-Sn-In alloy and a Ag-Sn-Bi alloy, to which cadmium, zinc or the like should be added. The present claims encompass a silver alloy "consisting of" silver, indium and tin with specific ranges for the total amount of the additives indium and tin. The closed language "consisting of" excludes elements not recited in the claim except for impurities. See M.P.E.P. § 211.03. Therefore, the claims exclude alloys containing more than 0.5% total Sn and In.

The Shibata I Ag-Sn-Bi alloy certainly cannot anticipate or render obvious the claimed alloy here, since it contains bismuth, which is excluded from the claim here. The Shibata I Ag-Sn-In alloy also cannot anticipate or render obvious the alloy claimed here since the cited portion of that reference teaches that alloys can contain a great deal more total Sn and In than what is claimed here. Shibata I also teaches that additional elements may be added to these alloys, while

this is excluded from the claims here. Moreover, the claims are amended here to incorporate the feature of claim 4, which is not rejected here.

Applicants request withdrawal of this rejection.

Claims 1-5 are rejected as obvious over Carrano (U.S. Patent No. 6,139,652; hereinafter "Carrano"). Carrano is cited as teaching a silver alloy that contains 99.5% silver, with the balance being selected from an element of a group that includes tin and indium. The alloys claimed by Carrano are binary alloys which contain silver and an element additive. Column 1, lines 48-58 of Carrano, cited by the Office, states that the balance "consist[s] essentially of an oxide of an element..." (emphasis added). Carrano does not disclose any alloy that contains Ag, Sn and In. This disclosure does not overlap the alloys claimed here or render them obvious. Because the Office has cited no teaching that renders the claimed silver alloys obvious, this rejection should be withdrawn.

Claim 6 is rejected as obvious over Shibata I or Carrano in view of Okamura et al. (U.S. Patent No. 6,104,530; hereinafter "Okamura"). Applicants refer the Office to the discussion above with respect to Shibata I and Carrano and submit that claim 6 cannot be obvious over this combination of references even if one accepts the Office's contentions concerning Okamura. For that reason alone, this rejection should be withdrawn.

Claim 7 is rejected as obvious over Shibata I or Carrano in view of Shibata (U.S. Patent No. 6,338,889; hereinafter "Shibata II"). Applicant refers the Office to the discussion above with respect to Shibata I and Carrano and submit that claim 7 cannot be obvious over this combination of references even if one accepts the Office's contentious concerning Shibata II. These references do not render obvious the compositions of claim 1, and addition of Shibata II cannot overcome their deficiencies. For that reason alone, this rejection should be withdrawn.

Applicants request reconsideration of the claims at this time.

This response is timely. The Office is authorized to charge Deposit Account 02-2135 with any fees deemed necessary with respect to this submission.

Respectfully submitted,

By



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